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The opinion in support of the decision being entered today
was **not** written for publication and
is **not** binding precedent of the Board.

Paper No. 30

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN J. YOHANAN

Appeal No. 2005-0043
Application No. 09/557,149

ON BRIEF

Before RUGGIERO, BARRY and NAPPI, **Administrative Patent Judges**.

NAPPI, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 of the final rejection of claims 3 through 12, which constitute all the claims remaining in the application. For the reasons stated *infra* we reverse the examiner's rejection of claims 3 through 12 and enter a new grounds of rejection.

Invention

The invention relates to a system for use on a computer where there is a desktop icon that is associated with a file containing a network address corresponding to a network location. (See page 4 of appellant's specification.)

Claim 3 is representative of the invention and reproduced below:

A graphical interactive method for permitting a computer system to access a web site, the method comprising the steps of:

displaying a desktop icon on a desktop, said desktop icon associated with an address of the web site;

launching a web browser application in response to a user of said computer system selecting said desktop icon for execution; and

accessing the web site using said web browser application and said address of the web site.

References

The references relied upon by the examiner are:

Cardinal et al. (Cardinal)	5,799,318	August 25, 1998 (effectively filed April 13, 1993)
Doyle et al. (Doyle)	5,838,906	November 17, 1998 (filed October 17, 1994)

Rejection at Issue

Claims 3 through 12 stand rejected under 35 U.S.C. § 103 as being obvious over Cardinal in view of Doyle. Throughout the opinion we make reference to the Briefs[1] and the answer for the respective details thereof.

Opinion

We have carefully considered the subject matter on appeal, the rejection advanced by the examiner and the evidence of obviousness relied upon by the examiner as support for the rejection. We have, likewise, reviewed and taken

[1]Appellant filed an Appeal Brief on October 14, 2003 and appellant filed a Reply Brief on March 1, 2004.

into consideration, in reaching our decision, the appellant's arguments set forth in the briefs along with the examiner's rationale in support of the rejection and arguments in rebuttal set forth in the examiner's answer.

With full consideration being given to the subject matter on appeal, the examiner's rejection and the arguments of appellant and the examiner, for the reasons stated *infra* we will not sustain the examiner's rejection of claims 3 through 12 under 35 U.S.C. § 103. However, in accordance with 37 CFR § 41.50(b), we enter a new grounds of rejection against claims 3, 9, 10, 11 and 12, under 35 U.S.C. § 103.

Appellant argues, on pages 13 and 15 of the brief, that though Cardinal teaches various icons, none are a desktop icon on a desktop capable of launching a web browser to access a web site. Further, on page 16 of the brief, appellant argues that the second reference, Doyle also does not teach displaying a desktop icon associated with an address of a web site. Appellant concludes, on page 17 of the brief, that the combination of Cardinal and Doyle do not teach the subject matter of claims 3 and 9 through 12. On pages 19 through 22 of the brief, appellant provides several arguments directed to the rejection of independent claims 4, 5, and 6 and including the arguments made with respect to claims 3 and 9 through 12.

The examiner in response, on page 3 of the answer, asserts that Cardinal discusses, in column 10 lines 34-60, selecting icons to launch applications.

Further, the examiner states:

> [a]s for appellant's remark that this browser does not access websites, Examiner is not denying that. That is why the Doyle et al reference was needed as evidence in addition to Cardinal et al in the form of a 103 based combination. The Doyle et al. reference does indeed mention accessing the web, links to the web (column 9 lines 50-65 as just one example) in a browser environment.

Before we consider the art applied, we must first determine the scope of the claim. Independent claim 3 includes the limitations of "displaying a desktop icon on a desktop, said desktop icon associated with an address of the web site; launching a web browser application in response to a user of said computer system selecting said desktop icon for execution; and accessing the web site using said web browser application and said address of the web site." The term icon and desktop are defined in appellant's specification on page 6; "[a]n icon refers to an object displayed by an output monitor on the 'desktop' (i.e., workspace) of a computer system employing a GUI [Graphical User Interface]; the object is associated with a computer file available to the computer's operating system." Thus, we find that the scope of claim 3 includes a graphical object (icon) on the computer's workspace (desktop) which when the object is selected causes a web browser to launch and access a web site associated with the icon. We find that claims 9-12 contain similar limitations and are of similar scope. Independent claims 4, 5, and 6 include similar limitations of displaying an icon and launching a web browser, however these claims are narrower as they also include additional limitations not present in claims 3 and 9 through 12 (i.e. claim 4, "accessing the web site using an already executing web browser," claim 5

"launching a web browser application...if said web browser is not currently executing," claim 6, "receiving a desktop icon ... from a second computer system").

We find that the combination of Cardinal and Doyle do not teach displaying an icon on a desktop which when selected causes a web browser to launch and access a web site associated with the icon. We find that Cardinal teaches that icons can be associated with files and selecting the icon can bring up the file. (See column 5, lines 34-36 and column 6, 63-67). Cardinal teaches that the file associated with the icon can be at a remote location. (See column 4, lines 14-16). However, we do not find that Cardinal teaches or suggests that the icons launch a browser to access a web site associated with the icon.

We find that Doyle teaches that web pages, hypertext and hypermedia documents, are displayed on a web browser and contain icons that link to other media documents. (See column 2, lines 22-27). We find that the icons in the hypertext and hypermedia documents are associated with the address of the additional information (web pages). (See column 2, lines 37-46 and lines 62-65). However, we find no teaching or suggestion in Doyle that the icons which link to additional data are on a desktop, rather Doyle teaches that the icons are within a web page. Thus, we find that neither Cardinal nor Doyle teaches an icon on a desktop which when selected causes a web browser to launch and access a web site associated with the icon. Accordingly, we will not sustain the examiner's rejection of claims 3 through 12.

New grounds of rejection under accordance with 37 CFR § 41.50(b).

We find two new pieces of evidence, NCSA Mosaic Version History (NCSA article) (pages 1-15 printed from web site "ww.ncsa.uiuc.edu/Divisions/PublicAffairs/MosaicHistory/history.html" and Kate Barnes, "10 Minute guide to Windows ™ 3.1, Quick lessons for Success" (1992 pages ix, x, 40-41, 126, 127 (Barnes)))(both references attached), that make obvious the invention of claims 3 and 9 through 12. Accordingly, we now enter a rejection of independent claims 3, 9 through 12 under 35 U.S.C. § 103.

The NCSA Mosaic Version History provides a time line of the development of features in the various versions of the Mosaic web browser. The time line identifies that version 0.4 of Mosaic included the option to automatically load a home page (a web site). (See page 2 of the NCSA article). The time line also shows that this feature was released on September 16, 1993, as part of version 0.5.[2] We find that this article teaches that the web browser available on September 16, 1993, automatically loaded a home page, a web site, when the browser was launched. However, the NCSA article does not teach the use of icons on a desktop.

[2] We note that on November 19, 2001, appellant submitted a declaration under 37 C.F.R. § 1.131 establishing a conception date prior to January 1, 1995, which the examiner acknowledged and accepted (see the office action dated February 14, 2002). In the reply brief, appellant presents a reproduction of an e-mail to establish the conception date as November 22, 1994. As appellant has not submitted the new evidence in accordance with 37 C.F.R. § 1.131, we do not consider November 22, 1994, as the conception date for the claimed invention. Nonetheless, we note that the evidence we rely upon in the new grounds of rejection teaches activity by others prior to November 22, 1994.

Barnes provides a tutorial of Windows ™ 3.1, a computer operating system available in 1993. Barnes teaches that in the Windows™ 3.1 operating system a user runs a program by selecting (double-clicking) an icon associated with the program. (See Barnes page 41). Barnes also teaches that the icons can be located on the desktop. (See Barnes page 127, which discusses adjusting the spacing between icons on the desktop and figure 203, which shows the icon for "Dr. Watson" on the desktop).

We find that the combination of the Mosaic program version 0.5 running on a computer with the Windows™ 3.1 operating system makes obvious the invention claimed in claims 3, and 9 through 12. As stated *supra*, the scope of these claims includes a graphical object (icon) on the computer's workspace (desktop) which when the object is selected causes a web browser to launch and access a web site associated with the icon. We find that using the Mosaic program on a machine with the Windows™ 3.1 operating system would require an icon associated with the Mosaic program to be displayed. Since launching the Mosaic web browser automatically loads a home page (web site), the icon associated with Mosaic would also necessarily be associated with the home page (web site). Accordingly, we find that the combination of the Mosaic program and the Windows™ 3.1 operating system teaches an icon (associated with the home page, a web site) to be displayed on the computer's workspace and that when the icon is selected the web browser is launched and the web site (home page) associated with the icon is accessed.

We find that the articles provide the motivation to use these two programs together. Barnes teaches that the reason to use the Windows ™ 3.1 operating system is that the operating system "makes the computer easier to use and increases the 'fun factor'." (See Barnes page ix). Thus, we find that the skilled artisan, at the time of the invention would have been motivated to use Mosaic on a computer with the Windows ™ 3.1 operating system, as it would have made it easier for a user to operate the computer. Accordingly, we now reject claims 3 and 9 through 12 under 35 U.S.C. § 103.

Conclusion

We will not sustain the examiner's rejection of claims 3 through 12 under 35 U.S.C. § 103.

In accordance with 37 CFR § 41.50(b), we have entered a new rejection of claims 3 and 9 through 12 under 35 U.S.C. § 103 as being obvious over version 0.5 of the program Mosaic as discussed in the web article "NCSA Mosaic Version History" and the Windows™ 3.1 operating system as discussed by Barnes "10 Minute Guide to Windows™ 3.1, quick lessons to windows Success!"

This decision contains a new ground of rejection pursuant to 37 CFR § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 CFR § 41.50(b) provides "[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review."

37 CFR § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

> (1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .
>
> (2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a) (1) (iv).

Reversed
37 CFR § 41.50(b)

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